



## Stipulated Motion to Stay Denied Until All Defendants Agree to be Bound by IPR Estoppel

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In a patent infringement litigation in the U.S. District Court for the Eastern District of Texas, Judge Rodney Gilstrap denied a joint motion to stay the litigation pending resolution of *inter partes* review when it was uncertain that all defendants would be bound by the statutory estoppel provision of 35 U.S.C. § 315(e).

Plaintiff sued two related corporate defendants alleging infringement of three patents. After the PTAB instituted IPR petitions filed by a third party challenging the patents-in-suit, defendants filed an opposed motion to stay pending resolution of those IPRs. The PTAB then instituted IPRs filed by one of the two defendants challenging the patents-in-suit, and plaintiff withdrew its opposition to the stay.

Although all parties stipulated to the motion to stay, the court denied the motion without prejudice, noting that the other defendant had neither joined the IPRs nor expressly agreed to be bound by the statutory estoppel provision. According to the court, without estoppel, the other defendant would effectively have a second bite at the apple, being able to advance new invalidity theories that petitioner-defendant reasonably could have raised during the IPRs.

The court allowed the parties to renew their motion to stay, which the parties did. Defendants included a statement that the other defendant agreed to be estopped to the full extent of the estoppel statute and to the same extent as petitioner-defendant, noting that it had indicated its agreement in defendants' previously opposed motion to stay. The court

granted the motion, staying the case pending all final written decisions on the IPR proceedings against the patents-in-suit.

**Practice Tip:** Parties seeking a district court stay pending resolution of IPR should consider whether all defendants can agree to be bound by the IPR estoppel provision. If so, the defendants should include a statement to that effect in a motion to stay, especially where one or more defendants are not petitioners in the IPR. When it is unclear that a defendant is bound by IPR estoppel, a district court may deny a motion to stay, even if filed as a stipulated motion, because of potential unfairness and waste of judicial resources.

*Maxeon Solar Pte. Ltd. v. Hanwha Sols. Corp. et al.*, Civil Action No. 2:24-cv-00262-JRG, D.I. 56 (E.D. Tex. May 1, 2025)

## Categories

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